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EXAMINER	
ABDI, KAMBIZ	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/468,611	REMER ET AL.	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

3. Applicant has failed to clearly indicate what claims have been canceled or amended in the beginning of the remarks section. However it appears that claim 41 has been canceled as well as amendments to claims 1, 13, 32, 35 and 39.

Status of Claims

- Claims 1, 13, 32, 35, and 39 are amended.
- Claim 41 is canceled.
- No new claims are added.
- Claims 1,2,4-7,9,10,13,25,27-29 and 31-40 have been considered.

Response to Arguments

4. Applicant's arguments filed 6 June 2005 have been fully considered but are not persuasive.

Applicant's point of contention in the claims is that the communication is initiated by the server and not by the client. However, the claims as they have been written and amended in their current form do not reflect such limitation and clearly contradicts the assertion made by the applicant. The claim 1 as the representative claim states, "receiving, by the local computer, a ping from a remote computer." Clearly the local computer is capable of receiving the ping from the remote computer as it has been admitted by the applicant (See page 10 of response filed on 6 June 2005). As for the asserted point of contention by the applicant "the client initiates the license procurement and/or validation and not the reverse." It is examiner 's understanding that there would be no action necessary as from the part of the server if there is no initiation from the local computer (client), the remote computer (server) is pinging in response to the initial request of the local computer (client) to inquire the legitimacy of the local computer (client) and establishment of a trust relation between the remote computer (server) and the local computer (client) as it is clearly stated by the claims. As it is clearly stated by the claims 1, 13, 35, and 39 "generating, on a

local computer, an install license for software installed on the local computer *in response to the software being installed; receiving, by the local computer, a ping from the remote computer;*" (Emphasis added). Therefore, the argument put forward by the applicant is clearly in contradiction with what the claims are directed to, and asserted by the applicant that, "Misra cannot teach receiving, by the local computer, a ping from a remote computer..." However Misra clearly teaches that (See Misra Col. 4, lines 59-64).

It is clearly disclosed by the Misra reference that a local computer receives a challenge (ping) from a remote computer and responding to such challenge (pong) via a communication network (Misra Col. 10, lines 7-12, Col. 16, lines 13-24).

In response to applicant's argument towards the *prima facie* case of obviousness, examiner would like to note that it is not necessary that references actually suggest, expressly or in so many words, the changes or possible improvements the applicant has made. *In re Sheckler*, 58 CCPA 936, 438 F.2nd 999, 168 USPQ 716 (1971). Also references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. Additionally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, examiner, test of obviousness is not what references expressly suggest but rather what the references taken collectively would have suggested to those skilled in the art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-35, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1 in view of Gradient, "Gradient Introduces End User Software License Creation and Delivery Tool For Its iFOR/LS Licensing Technology, dated 21 March 1994 and Rose, U.S. Patent No. 5,708,709.

As per **Claims 1, 13 and 33-34**, Misra et al discloses a method for licensing software comprising:

- generating, on a local computer, a first install license for software installed on the local computer (Misra Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);

- receiving, by the local computer, a ping from a remote computer (Misra Col. 10, lines 7-12, Col. 16, lines 13-24);

- obtaining, by the local computer in response to generating the install license and receiving the ping, from the remote computer a second license for software installed on the local computer, wherein the second license is generated by the remote computer (Misra Col. 2, lines 48-61; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53, Col. 10, lines 7-12, Col. 16, lines 13-24);

- determining, by the local computer, whether the second license is authentic (Misra Col. 15, lines 29-49), and

- replacing, if the second license is authentic, the install license with the second license (Misra Col. 15, lines 37-49; Col. 16, lines 49-67);

- selectively refreshing the second license prior to expiration of the second predetermined period of time (Misra Col. 14, lines 14-51; Col. 16, lines 49-67).

Misra et al discloses the generation of an install license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a local computer generates the install license. Misra further fails to explicitly disclose that the second license is a trial license. Gradient discloses a license delivery and installation tool the enables end users to create software licenses of different types on their own system without outside intervention and further teach that end users can create their own "try and buy" demo licenses for software and later, if the user

chooses to purchase an operational license, the desired license type may be selected from an options menu and installed. Gradient teaches that authorized end users are able to instantly create short-term licenses and allows end users, working at their own PC, to select from a variety of licensing options and to create licenses of a variety of different types such as "try and buy" licenses that are installed within a single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer such as a end user to create their own license and store this license on the first computer wherein the license is valid for an extended period of time such as an install license or for a predetermined short-term period of time as taught by Gradient. Gradient provides motivation by indicating that this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the cost of license creation and delivery and further provides end users with complete control over their software purchase and deployment decisions.

Misra clearly discloses the concept and use of challenge and response methods and system for preventing a third party from replaying exchanges between client and server. As it is clearly understood and would have been obvious to one skill in the art that pinging (Packet Internet Groper) is a primitive form of challenge and response and it is used often for determination of the pinged node's ability to send and receive transmissions. A ping is testing of whether a particular computer is connected to the Internet by sending a packet to its IP address and waiting for a response (Misra Col. 10, lines 7-12, Col. 16, lines 13-24). Usually this primitive form of challenge and response called Ping is used for conservation of less bandwidth in communication.

Misra further suggests the use of a temporary or trial license to replace an existing license (Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose discloses a system and method for managing try-and-buy usage of application programs and teaches the installation of a trial version application along with the trial license for the application (Figure 9A-9B). Rose further discloses later replacing the original trial license with another trial license (Col. 11, lines 3-15) to enable continued use of the software. Examiner submits that the first trial license disclosed by

Rose is equivalent to the install license recited in the claims since applicant discloses in the specification that the "install" license is always set to expire immediately and only used to initiate the generation of a trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since the install license is only temporary and does not provide unlimited use of the software. Therefore, it would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose provides motivation by indicating that this would provide the user with an opportunity to continue to use the software under a trial version which would help the user to decide whether or not he/she desires to purchase the operational license (Col. 11, lines 5-12).

As per **Claims 2 and 25**, Misra et al further disclose

- setting, by the local computer, a first identifier to associate the install license with the local computer (Misra Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 41-67);

- matching the unique identifier of the second license to the unique identifier of the install license, and if no matching occurs, discarding the second license without replacing the first license (Misra Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if authentication fails, discarding the second license without replacing the install license (Misra Col. 12, lines 8-15);

- replacing the install license with the second license if the second license is determined to be authentic (Misra Col. 16, lines 39-67).

Misra does not specifically disclose that the second license is a trial license, however, this was discussed above with reference to claim 1.

As per **Claims 10 and 32**, Misra et al further disclose wherein the licenses are digitally signed (Misra Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claims 4 and 27**, Misra et al further disclose wherein obtaining from the remote computer the second license further comprises:

- connecting to the remote computer (Misra Col. 14, lines 14-16)

- providing the remote computer with at least some of the data from the install license (Misra Col. 14, lines 24-30)

- exchanging the provided data from the install license for the second license (Misra Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6 and 28-29**, Misra et al further disclose wherein connecting to the remote computer comprises connecting to the remote computer via a communications network (Misra Col. 4, lines 43-49).

As per **Claim 7,** Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging the install license for the second license includes formatting data from the install license according to a set of text processing rules and transmitting the formatted data using a text transfer protocol. Examiner takes Official Notice that formatting data according to a set of text processing rules such as HTML or XML and transmitting the formatted data using a text transfer protocol such as HTTP was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use text processing rules such as HTML for formatting data and use a text transfer protocol such as HTTP for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

As per **Claims 9 and 31**, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Misra Col. 14, lines 30-48).

As per **Claims 35 and 37**, Misra et al discloses a method for licensing software comprising:

- generating, on a local computer, a first install license in response to installing a software on the computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);

- storing, on the computer, the software install license as pong data (Misra Col. 10, lines 7-12, Col. 16, lines 13-24);

- receiving , by the computer, a ping from an external software license servicing agent to detect the software install license in the pong data (Misra Figure 5; Col. 14, lines 1-29, Col. 10, lines 7-12, Col. 16, lines 13-24);

- generating a software temporary license in response to receiving the ping from the external software license servicing agent (Misra Figure 5, Col. 14, lines 1-29 and Col. 17, lines 7-35).

Misra et al discloses the generation of an install license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a local computer generates the install license. Misra further suggests the use of a temporary or trial license to replace an existing license (Misra Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license and that this license is generated by the local computer. Gradient discloses a license delivery and installation tool the enables end users to create software licenses of different types on their own system and further teach that end users can create their own "try and buy" demo licenses for software and later, if the user chooses to purchase an operational license, the desired license type may be selected from an options menu and installed. Gradient teaches that authorized end users are able to instantly create short-term licenses and allows end users, working at their own PC, to select from a variety of licensing options and to create licenses of a variety of different types such as "try and buy" licenses that are installed within a single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer such as a end user to create their own license and store this license on the first computer wherein the license is valid for an extended period of time such as an install license or for a predetermined short-term period of time as taught by Gradient. Gradient provides

motivation by indicating that this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the cost of license creation and delivery and further provides end users with complete control over their software purchase and deployment decisions.

Misra further suggests the use of a temporary or trial license to replace an existing license (Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose discloses a system and method for managing try-and-buy usage of application programs and teaches the installation of a trial version application along with the trial license for the application (Figure 9A-9B). Rose further discloses later replacing the original trial license with another trial license (Col. 11, lines 3-15) to enable continued use of the software. Examiner submits that the first trial license disclosed by Rose is equivalent to the install license recited in the claims since applicant discloses in the specification that the "install" license is always set to expire immediately and only used to initiate the generation of a trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since the install license is only temporary and does not provide unlimited use of the software. Therefore, it would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose provides motivation by indicating that this would provide the user with an opportunity to continue to use the software under a trial version which would help the user to decide whether or not he/she desires to purchase the operational license (Misra Col. 11, lines 5-12).

As per **Claim 38**, Misra et al further disclose receiving, by the computer, a purchased software license from the external software licensing agent (Misra Col. 4, lines 25-30; Col. 16, lines 38-67); and replacing the first license with the purchased software license (Misra Col. 16, lines 38-67).

7. Claims 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1 in view of Rose, U.S. Patent No. 5,708,709.

As per **Claims 39**, Misra et al disclose a method comprising:

- pinging, by a software license servicing agent, a computer to detect a software install license (Misra Figure 5; Col. 14, lines 1-29);

- receiving, by a software license servicing agent, pong data including a software install license from the computer in response to pinging the computer (Misra Figure 5; Col. 4, lines 64-67, Col. 14, lines 1-29, Col. 10, lines 7-12, Col. 16, lines 13-24);

- generating, by the software license servicing agent, a second license in response to receiving the software install license (Misra Col. 2, lines 48-61; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53).

Misra further suggests the use of a temporary or trial license to replace an existing license (Misra Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose discloses a system and method for managing try-and-buy usage of application programs and teaches the installation of a trial version application along with the trial license for the application (Figure 9A-9B). Rose further discloses later replacing the original trial license with another trial license (Col. 11, lines 3-15) to enable continued use of the software. Examiner submits that the first trial license disclosed by Rose is equivalent to the install license recited in the claims since applicant discloses in the specification that the "install" license is always set to expire immediately and only used to initiate the generation of a trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since the install license is only temporary and does not provide unlimited use of the software. Therefore, it would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose provides motivation by indicating that this would provide the user with an opportunity to continue to use the software under a trial version which would help the user to decide whether or not he/she desires to purchase the operational license (Col. 11, lines 5-12).

8. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

9. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Horstmann discloses that an end user's machine is installed with a license certificate which typically is installed during original installation of a software product and further including a relicensing manager
- Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades
- Coley et al disclose an automated system for management of licensed software and enabling or disabling the software accordingly
- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate
- Horstmann discloses a method of relicensing of electronically purchased software
- Knutson discloses a method for licensing computer programs using DSA signature
- Carter et al disclose a method for network license authentication
- Cohen discloses a method for software licensing electronically distributed programs

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

http://portal.uspto.gov/external/portal/pair.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner

August 29, 2005